

### **REMARKS/ARGUMENTS**

Claims 14, 15, 20, and 23-40 remain under consideration in the present application. In the Office Action dated August 16, 2006, Claims 14, 15, 20, and 23-39 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,297,795 to Kato et al. ("Kato"). Claim 40 is indicated as being allowable if rewritten in independent form including all of the limitations of the base claims. In response to the Office Action, Applicant has amended independent Claims 14, 37, and 38. As explained below, Applicant respectfully submits that the claimed invention of amended independent Claims 14, 37, and 38, and by dependency Claims 15, 20, 23-36, 39, and 40, are patentably distinct from the Kato patent. As such, Applicant respectfully requests reconsideration and allowance of all of the pending claims of the present application.

Amended independent Claim 14 is directed to a portable device comprising a user input. The user input comprises a key operable in response to a first mode of operation to perform a first function of performing a shortcut to a predetermined menu when the device is in a first state. The key is also operable in response to the first mode of operation to perform a second function of performing a shortcut back to the first state when the device is not in the first state. The key is further operable, in response to a second mode of operation, to turn the device on or off. Amended independent Claims 37 and 38 relate to a corresponding method of operating such a device and a computer program, respectively.

For example, page 19 and FIG. 12 of the specification describe one embodiment of the claimed invention. In this embodiment, a phone has a button having multiple functions where the function of the button is determined by the state of the phone. If the phone is in idle mode and the button is pressed, the profiles menu is accessed. *See* Steps **122** and **123** of FIG. 12. If the phone is not in idle mode and the button is pressed, "then the processor exits all menus and returns the phone to idle mode." *See* p.19, ¶ 3 and Steps **122** and **124** of FIG. 12. This feature of the key having a second function of performing a shortcut to the first state provides the user with quick access to and from a menu. The user can quickly exit any menu level without having to scroll through further menu levels or select an item from the menu level. For example, this feature may be particularly useful if the user inadvertently enters a menu level and desires to quickly return to the first state.

The Kato patent relates to an information processing apparatus having a relatively small display screen. Information can be displayed on the display screen in either portrait or landscape mode. The apparatus comprises a rotary switch **12**. The function of the rotary switch **12** depends upon the state of the apparatus and the mode of operation of the switch. For example, rotating the key causes the apparatus to scroll through information, such as a list of menu options displayed on the display, and pressing the rotary switch causes a selection of the menu option or the entering of a menu.

The rotary key of Kato is operable to enter a menu from a first state. For example, as illustrated in FIG. 7 of Kato momentarily pressing the rotary switch when a document is displayed causes the apparatus to display a pop-up menu. There is no disclosure, however, of the rotary switch having a second function of providing a shortcut to the first state. The Office Action, however, submits that the rotary switch **12** in Kato is operable to perform a shortcut to the main menu state because “in figure 12, if the key (**12**) is moved to ‘SET’, the second function will perform returning the state to the first state.” *See* the Office Action, page 4. However, the Applicant submits that selecting “SET” is not “performing a shortcut,” as recited by the independent claims of the present application. Although selecting “SET” in Kato will return the device to the main menu state, it will also cause any currently selected option to be set as the current configuration of the device. *See* Kato, col. 11, lines 53-58. The Applicant maintains that this is not “performing a shortcut” as a shortcut enables a user to exit a menu without having to select an item from that menu. Therefore, Kato does not disclose a key having a second function of performing a shortcut back to the first state when the device is not in the first state, as recited by the independent claims of the present application.

Furthermore the Kato patent also does not disclose a key operable to turn the device on and off, as further recited by the amended independent claims of the present application. In contrast, in the Kato patent the rotary button **12** is operable to turn the device on and the cancel button **13** is operable to turn the device off. *See* Kato, col. 10, lines 53- 58.

Therefore the Kato patent does not disclose a key having all of the functions or features recited by the independent claims of the present application. In particular, Kato does not disclose a key having at least three functions, where the three functions include: a first function

of performing a shortcut to a predetermined menu when the device is in a first state; a second function of performing a shortcut back to the first state when the device is not in the first state; and a third function, in response to a different mode of operation of the key, of turning the device on and off.

It should be appreciated that the features and functions of the claimed invention may provide an advantage in that they allow a single key to provide the plurality of functions, namely providing access to and from a menu and providing a way to turn the device on and off. This may be particularly advantageous for devices such as portable radiotelephones, where the amount of space available for a user input is limited.

In contrast, Kato teaches that it is advantageous to have a cancel button **13** separate from the rotary key **12** in order to assist in a selection operation. In Kato, the cancel button **13** performs functions such as exiting a menu if, for example, it has been entered erroneously. Therefore, Kato teaches that it is advantageous to provide opposing features in separate keys. *See* Kato, col. 9 lines 37-47. There is no suggestion in the teachings of Kato that would motivate a person of ordinary skill in the art to modify the teachings therein to produce the claimed invention. Therefore, for the abovementioned reasons, the Applicant maintains that the present invention is both new and non-obvious with respect to the cited prior art.

As such, Applicant requests that the rejection of Claims 14, 15, 20, and 23-40 under 35 U.S.C. § 102(e) be withdrawn and that all of the pending claims of the present application be allowed.

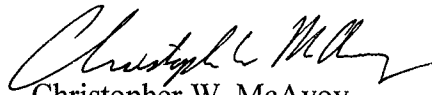
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### **Conclusion**

In view of the amended claims and the remarks presented above, it is respectfully submitted that all of the claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

  
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